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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,129	01/20/2004	Hiromu Ando	Q79438	6649
23373 7590 06/23/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER				
LAMB, BRENDA A				
ART UNIT		PAPER NUMBER		
1792				
MAIL DATE		DELIVERY MODE		
06/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/759,129

**Applicant(s)**

ANDO ET AL.

**Examiner**

Brenda A. Lamb

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/11/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,6,7 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6,7 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claims 1,3,6,7 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichikawa et al 2004/0043154 or Japan 2003-275642 (Ichikawa et al) in view of Wallsten 4,102,299 and Mandai et al 2003/0099769.

Ichikawa et al teaches as shown in Figure 1 a coating apparatus for coating with coating liquid a surface of a strip-shaped body carried in a fixed direction, the apparatus comprising: a primary bar extending along a width direction of a carrying plane, which is a carrying path of the strip-shaped body; a secondary bar extending in parallel with the

primary bar and disposed at a downstream side of the primary bar; and a between-bars liquid reservoir disposed between the primary bar and the secondary bar for storing the coating liquid at a time of coating of the coating liquid, wherein the coating apparatus further comprises a backup member, an assembly of elements which include platform elements and bar supporting elements, supporting the primary bar and the secondary bar from below, wherein the liquid reservoir is formed in the space defined by the primary bar, secondary bar and backup member. Ichikawa et al apparatus is capable of providing conditions at the primary bar and the secondary bar such that  $1 < W_1 / W_2 < 1.3$  where  $W_1$  is a coating amount of the coating liquid that is deposited on the strip-shaped body at the primary bar and  $W_2$  is a coating amount of the coating liquid that is deposited on the strip-shaped body after the strip-shaped body has passed the secondary bar via adjustment of the secondary bar as taught by Ichikawa et al. Further, Ichikawa et al coating apparatus is further comprised of an air-liquid interface forming portion provided at the between-bars liquid reservoir (see Figure 10 of Ichikawa et al 2004/0043154 and Figure 1 of Japan 2003-275642). Ichikawa et al includes a discharge outlet or pipe for discharging liquid collected in the between-bars liquid reservoir (see element 6D in Figure 10 of Ichikawa et al 2004/0043154 and see element 6E in Figure 1 of Japan 2003-275642). Ichikawa et al fails to teach the air-liquid interface forming portion includes a coating liquid sucking out portion for sucking out the coating stored in the between-bars liquid reservoir. However, it would have been obvious to modify the Ichikawa et al apparatus by connecting its discharge outlet or pipe for discharging liquid collected in the between-bars liquid reservoir to a vacuum source

to create a coating liquid sucking out portion of the air-liquid interface forming portion since Wallsten and Mandai et al teaches connecting the chamber downstream for collecting excess coating or between-bars liquid reservoir to a vacuum source for sucking out the excess coating for recycling ( vacuum source 20 of Wallsten and suction pump 144 of Mandai et al). With respect to claim 7, Ichikawa et al as modified is capable of coating a strip-shaped body within the scope of the claim and is capable of coating the substrate with a liquid within the scope of claim since Ichikawa et al as modified teaches every element of the claimed apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 23, the same rejection applied to claim 1 is applied here. Further, Ichikawa et al as modified teaches the primary bar is wire bar comprised of a wire wound around a rod (see Ichikawa et al at paragraph 0068). With respect to claim 3, Ichikawa et al as modified teaches at paragraph 0068 the primary bar is wire bar comprised of a wire wound around a rod. Ichikawa et al as modified apparatus is capable of achieving a coating amount  $W_l$  within the scope since it teaches the apparatus has each of the claimed structural elements set forth in claim. With respect to claim 6, it would have been obvious given the modifications of Ichikawa et al apparatus as discussed above to re-circulate the coating from the coating liquid sucking out

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portion to Ichikawa et al primary coating liquid supply flow path since both teach recirculating coating upstream to the applicator for the obvious cost advantage of doing so.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton, can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brenda A Lamb  
Examiner  
Art Unit 1734

/Brenda A Lamb/

Primary Examiner, Art Unit 1792

